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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/822,432
Filing Date: April 12, 2004
Appellant(s): Jean-Luc Collet, Francois-Xavier Drouet, Gerard Marmigere,
Joaquin Picon

John A. Merecki (35,812)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 9, 2008 appealing from the Office action mailed March 6, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5870548	NIELSEN	02-1999
US 6721784 B1	LEONARD	04-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1-16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen, U.S. Patent 5,870,548 in view of Leonard et al (hereinafter Leonard), U.S. Patent 6,721,784.

As per Claim 1, Nielsen in view of Leonard discloses a system for enabling the cancellation of a previously-sent e-mail [Abstract], comprising a data transmission network, wherein a plurality of users are connected to said network [Figs. 1a-b & 2], each of said users being able as a sender (200) to send an e-mail (i.e., 'email') over said network to a plurality of users as recipients connected to said network (202), and wherein a message transfer agent (MTA) (203/207) is associated with each of said

users for sending the e-mail when said user acts as a sender and delivering the e-mail when said user acts as a recipient [Fig. 2],

wherein each MTA includes a cancel mailbox (e.g., sender's outbox_204) for transmitting a cancellation message (i.e., "cancellation message") [col 4, L37-47] to said recipients when the user associated with said MTA is a sender wanting to cancel a previously-sent e-mail (i.e., "previously sent email") or for managing the cancellation of e-mails in the mailbox of the user associated with said MTA upon receiving said cancellation message from said sender when this user is a recipient [col 3, L5-50] [col 3, L56 – col 4, L3],

wherein the cancel mailbox of each MTA is configured to cancel the e-mail sent to the recipients only when none of the recipients has read the e-mail, and is configured to not delete the e-mail when any of said recipients has read said email [Leonard: Abstract] [col 1, L60-62] [col 5, L40 – col 6, L10] [col 10, L19-28].

While Nielsen discloses substantial features of the invention such as the system of claim 1, the added feature of the process wherein the cancel mailbox of each MTA is configured to cancel the e-mail sent to the recipients only when none of the recipients has read the e-mail, and is configured to not delete the e-mail when any of said recipients has read said email, is expressly disclosed by Leonard in a related endeavor.

Leonard discloses as his invention an electronic mail system and method in which the originator or sender may control the lifespan of the message, so that the message, and all copies of the messages everywhere in the world, disappear at an

appropriate time [col 9, L10-15]. In particular, Leonard discloses the added feature of the process wherein the cancel mailbox of each MTA is configured to cancel the e-mail sent to the recipients only when none of the recipients has read the e-mail, and is configured to not delete the e-mail when any of said recipients has read said email. (e.g., tracking the messages of "individuals or groups of recipients" to whom the message have been sent) [Abstract] [col 1, L60-62] (e.g., groups of clients) [col 5, L40 – col 6, L10] [col 10, L19-28]. As disclosed and taught by Leonard, a 'recipient' of the electronic messaging or mail system may be embodied as an 'individual recipient' or a 'group of recipients', the electronic mail system tracking information concerning the usage (i.e., message 'read' and/or 'deleted') and handling of the message by all recipients.

It would thus be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Nielsen's invention with the above additional feature, as disclosed by Leonard, for the motivation of providing an electronic mail system and method that enables the originator of a message sent by the electronic mail to select a date, time, or event at which the message and all incarnations of the message to self-destruct regardless of the number and types of computers or software systems that may have interacted with the message, and/or to include processing and handling limitations [Abstract].

As per claim 2, Nielsen discloses the system according to claim 1, wherein there is at least an intermediate MTA between the MTA associated with said sender and said MTA associated with said recipients (e.g., 167) [Fig. 1a], said intermediate MTA including a

cancel mailbox (e.g., sender's outbox_204) [Fig. 2] in charge of transmitting a cancellation message to said MTAs associated to said recipients upon receiving said cancellation message from said MTA associated with said sender (i.e., "cancellation message") [col 4, L37-47] [Figs. 1a-b & 2].

As per claim 3, Nielsen discloses the system according to claim 1, wherein the cancel mailbox in each said MTA is associated with a cancellation agent for managing the cancellation of said e-mail, said cancellation agent building a delete process table giving a status of said e-mail during the cancellation process managed by said cancellation agent (e.g., 863 / 865) [Fig. 8D] (e.g., 'Delete Effectuated Message_1017') [Fig. 10a].

As per claim 4, Nielsen in view of Leonard discloses a process for canceling a previously-sent e-mail in a system comprising a data transmission network, wherein a plurality of users are connected to said network, each of said users being able as a sender to forward an e-mail over said network to a plurality of users as a recipient connected to said network, and wherein a message transfer agent (MTA) is associated with each of said users for sending the e-mail when said user acts as a sender and delivering the e-mail when said user acts as a recipient [col 3, L5-50] [col 3, L56 – col 4, L3] [Figs. 1a-b & 2]; said process comprising:

a) sending from said sender a message for deleting said e-mail to a cancel mailbox included in said sender MTA (409) [Fig. 4],

b) sending from said cancel mailbox included in the sender MTA a message to a cancel mailbox included in each MTA respectively associated with each recipient being addressed in said e-mail in order to inform the recipients that said e-mail has to be deleted if it is not yet read (1011 & 1017) [Fig. 10a] [col 4, L38-42],

c) sending from said cancel mailboxes of said MTAs respectively associated with said recipients a message requesting that said e-mail has to be masked only if it has not yet been read (1011 & 1017) [Fig. 10a] [col 4, L38-42], and

d) deleting said masked e-mail only when none of said recipients has read said e-mail (1011 & 1017) [Fig. 10a] [col 4, L38-42], and not deleting the masked e-mail when any of said recipients has read said e-mail.

While Nielsen discloses substantial features of the invention such as the system of claim 1, the added feature of the process deleting said masked e-mail only when none of said recipients has read said e-mail, and not deleting the masked e-mail when any of said recipients has read said e-mail is expressly disclosed by Leonard in a related endeavor.

Leonard discloses as his invention an electronic mail system and method in which the originator or sender may control the lifespan of the message, so that the message, and all copies of the messages everywhere in the world, disappear at an appropriate time [col 9, L10-15]. In particular, Leonard discloses the added feature of the process deleting said masked e-mail only when none of said recipients has read said e-mail, and not deleting the masked e-mail when any of said recipients has read

said e-mail (e.g., tracking the messages of "individuals or groups of recipients" to whom the message have been sent) [Abstract] [col 1, L60-62] (e.g., groups of clients) [col 5, L40 – col 6, L10] [col 10, L19-28]. As disclosed and taught by Leonard, a 'recipient' of the electronic messaging or mail system may be embodied as an 'individual recipient' or a 'group of recipients', the electronic mail system tracking information concerning the usage (i.e., message 'read' and/or 'deleted') and handling of the message by all recipients.

It would thus be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Nielsen's invention with the above additional feature, as disclosed by Leonard, for the motivation of providing an electronic mail system and method that enables the originator of a message sent by the electronic mail to select a date, time, or event at which the message and all incarnations of the message to self-destruct regardless of the number and types of computers or software systems that may have interacted with the message, and/or to include processing and handling limitations [Abstract].

As per claim 5, Nielsen discloses a process according to claim 4, wherein a cancel mailbox of a MTA associated with each recipient sends back an acknowledgement message (e.g., confirmation message) of a first type if said recipient has not yet read said e-mail (1011 / 1021) [Fig. 10a] (1117 / 1111) [Fig. 11a]..

As per claim 6, Nielsen discloses process according to claim 5, wherein the cancel mailbox of the MTA associated with several recipients sends back a first type message

to said sender MTA if none of these recipients has already read said e-mail (e.g., confirmation message) (1011 / 1021) [Fig. 10a] (1117 / 1111) [Fig. 11a].

As per claim 7, Nielsen discloses the process according to claim 6, wherein said step d) comprises sending from the cancel mailbox of said sender MTA a message to the cancel mailboxes of the MTAs associated with all the recipients addressed in said e-mail requesting each cancel mailbox to delete said e-mail (e.g., "Informing Recipient to Cancel the Message") [Fig. 6c].

As per claim 8, Nielsen discloses the process according to claim 7, wherein said step d) further comprises the step of sending a message from said cancel mailboxes of the MTAs associated with all recipients to the recipient mailboxes in order to delete said e-mail (e.g., "Informing Recipient to Cancel the Message") [Fig. 6c].

As per claim 9, Nielsen discloses the process according to claim 7, wherein the cancel mailbox of said sender MTA sends a first type acknowledgment message to the mailbox of said sender to confirm that said e-mail has been deleted (e.g., confirmation message) (1011 / 1021) [Fig. 10a] (1117 / 1111) [Fig. 11a].

As per claim 10, Nielsen discloses the process according to claim 4, wherein a cancel mailbox of a MTA associated with a recipient sends back an acknowledgment message

of a second type if said recipient has already read said e-mail (e.g., confirmation message) (1011 / 1021) [Fig. 10a] (1117 / 1111) [Fig. 11a] [col 4, L38-42].

As per claim 11, Nielsen discloses the process according to claim 10, wherein the cancel mailbox of the MTA associated with several recipients sends back a second type message to said sender MTA if at least one of these recipients has already read said e-mail (e.g., confirmation message) (1011 / 1021) [Fig. 10a] (1117 / 1111) [Fig. 11a] [col 4, L38-42].

As per claim 12, Nielsen discloses the process according to claim 11, wherein said step d) comprises sending from the cancel mailbox of said sender MTA a message to the cancel mailboxes of the MTAs associated with the recipients who have not yet read said e-mail requesting not to delete said e-mail (513 / 623) [Figs. 5 & 6c].

As per claim 13, Nielsen discloses the process according to claim 12, wherein said step d) further comprises the step of sending a message from said cancel mailboxes of the MTAs associated with the recipients who have not yet read said e-mail to the mailboxes of said recipients in order not to delete said e-mail (513 / 623) [Figs. 5 & 6c].

As per claim 14, Nielsen discloses the process according to claim 12, wherein the cancel mailbox of said sender MTA sends a second type acknowledgment message to the mailbox of said sender to confirm that said e-mail has not been deleted (e.g.,

confirmation message) [Figs. 9 & 10a].

As per claim 15, Nielsen discloses the process according to claim 4, wherein there is at least one intermediate MTA between said sender MTA and the MTAs associated with said recipients, said intermediate MTA being adapted to repeat any message received from the cancel mailbox of the sender MTA or from the cancel mailbox of any other MTA (167) [Fig. 1a].

As per claim 16, Nielsen in view of Leonard discloses the process according to claim 15, wherein at least one of said recipients is addressed by an alias, the cancel mailbox of the MTA receiving said alias being adapted to send a request to an associated domain name server (DNS) in order to obtain the address corresponding to said alias.

While Nielsen discloses substantial features of the invention such as the system of claim 1, the added feature of the process wherein at least one of said recipients is addressed by an alias, the cancel mailbox of the MTA receiving said alias being adapted to send a request to an associated domain name server (DNS) in order to obtain the address corresponding to said alias is disclosed by Leonard in a related endeavor.

Leonard discloses as his invention an electronic mail system and method in which the originator or sender may control the lifespan of the message, so that the message, and all copies of the messages everywhere in the world, disappear at an

appropriate time [col 9, L10-15]. In particular, Leonard discloses the added feature of the process wherein at least one of said recipients is addressed by an alias, the cancel mailbox of the MTA receiving said alias being adapted to send a request to an associated domain name server (DNS) in order to obtain the address corresponding to said alias [col 1, L60-62] [col 5, L40 – col 6, L10] (e.g., DNS registration system and 'assigned' recipient address or alias address) [col 15, L37 – col 16, L10]. As disclosed and taught by Leonard, a 'recipient' of the electronic messaging or mail system may be embodied as an 'individual recipient' or a 'group of recipients', the electronic mail system tracking information concerning the usage (i.e., message 'read' and/or 'deleted') and handling of the message by all recipients.

It would thus be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Nielsen's invention with the above added feature, as disclosed by Leonard, for the motivation of providing an electronic mail system and method that enables the originator of a message sent by the electronic mail to select a date, time, or event at which the message and all incarnations of the message to self-destruct regardless of the number and types of computers or software systems that may have interacted with the message, and/or to include processing and handling limitations [Abstract]

(10) Response to Argument

Claims 1-16

With regards to the claims, and claim 1 in particular, Applicant firstly argues that neither the Nielsen nor the Leonard prior art references applied by the Office in rejecting the claims teaches or discloses the particular limitations of claim 1 which currently recites, in part:

“...wherein the cancel mailbox of each MTA is configured to cancel the email sent to the recipients only when none of the recipients has read the email, and is configured not to delete the email when any of said recipients has read the email.”

The Office respectfully disagrees and submits that Applicant has misinterpreted and/or not fully considered all of the teachings and disclosures of the prior art references. The Office also asserts and maintains that all of the recited claim features argued by Applicant are taught by the prior art reference(s) consistent with the language of the current claim recitation.

With regards to the claim, and in support of his argument that neither Nielsen nor Leonard fully discloses the above limitation of claim 1, Applicant argues or remarks that “in the present invention, deletion of a previously sent email is an ‘all or nothing

process', in which the previously sent email is deleted only if none of the recipients has read the email; however, in Nielsen an email is deleted on a 'recipient-by-recipient' basis, irrespective of the reading actions of other recipients (i.e., in Nielsen, an email sent to a first recipient can be deleted even if another recipient has already read the same email). While the Office generally agrees with Applicant's comment regarding Nielsen's invention, the Office nevertheless asserts that the argued feature is taught or disclosed by the combination of Nielsen in view of Leonard.

Nielsen discloses as his invention a method, apparatus, and system for allowing the sender of an electronic mail message to delete or modify the message after it has been sent [Abstract] [col 1, L5-11 & L32-39] [col 2, L56 – col 3, L16]. Specifically, Nielsen expressly and significantly discloses that as part of his invention a 'cancel message' is generated to delete an email message already sent to a recipient. Nielsen expressly teaches that a 'cancel message' is an email message that

"is constructed to cause the recipient's email system to *delete* a previously-sent message that the recipient has not seen, or to notify the recipient of the sender's desire to cancel the previously-sent message that the recipient has seen."

[Nielsen: col 4, L38-42 & 53-59]

Further, with reference to Figures 10a-b and/or 11a-b, Nielsen expressly illustrates an embodiment wherein the system checks for a previously-sent message has been 'read' (e.g. "Has Effectuated Message been Seen?"_1011). In both cases the

previously-sent message is 'deleted'; however, in the case where the message has already been read by the recipient, a 'notification' message is also sent to the recipient to inform the recipient of the sender's desire to cancel the message, with the message being 'deleted' only with the recipients cooperation (step 1013) [col 14, L65 – col 15, L15] [Fig. 10-a-b]. In the case where the message has not yet been read by a 'recipient' the effected message is straightforwardly deleted (step 1017) [col 14, L45-64] [Fig. 10a-b]. Nielsen thus expressly at least two embodiments: one case wherein (a) a previously-sent email is deleted only when approved by the recipient and when a 'recipient' has already read / seen the message; and another case wherein (b) a previously-sent email message is deleted when the recipient has not yet read / seen the message. At least this much is taught or disclosed by Nielsen and this is also acknowledged by Applicant himself.

Thus, contrary to Applicant's remarks that "Leonard is completely unconcerned with the read status of an email when deleting emails, Nielsen actually 'checks to see' or tracks whether a previously-sent email has been 'seen'/read by a recipient, and depending on the 'status' deletes or processes the message accordingly.

Leonard, in a related endeavor, discloses an email system and method that enables the originator of a message sent by email to select a date, time, or an occurrence of an 'event' (condition) at which the message and all incarnations of the message 'self-destruct' [Abstract] [col 4, L50-63]. As acknowledged by Applicant

himself, "Leonard discloses that an originator of an email can delete a previously sent email 'completely independently of the actions' (e.g. reading, forwarding, copying, etc.) taken by any recipients of the email, and the number and types of computers/software that have interacted with the email [Applicants Arguments: page 5, Paragraph 3]. However, this does not mean that Leonard does not disclose an embodiment wherein 'actions' taken or not taken with respect to a message are not monitored or tracked and 'acted' upon accordingly. In fact, Leonard expressly discloses an user interface for 'tracking' whether a previously sent email message has been 'read' at least once or 'not read' at least once for a 'recipient' (e.g., 'Message Status' for J Jones shows that the message has been 'read'/seen at least once, while for Dr. Kay or Mom, the 'status' is that it has not yet been read) just for this very purpose [Figure 4].

Additionally, and as further support for the above assertion by the Office, the Office strongly asserts with emphasis that Leonard expressly and clearly teaches that

"It is the eleventh objective of the invention to provide an electronic mail system and method which 'tracks' information concerning the usage and handling of the message, by all recipients or any individual or 'group of recipients'....

[Leonard: col 10, L19-27] [Figure 5]

In this regard, the Office points to the significance of Leonard's express disclosure of the types of email message 'recipients' monitored by his invention. Leonard expressly teaches and distinguishes between an 'individual recipient', a 'plurality of individual recipients', and/or 'group of recipients' (i.e., 'groups of clients') [col

6, L10]. Leonard thus expressly discloses that a 'recipient' or addressee of a specific email message (indicated by the "TO:", CC:, or BCC: fields of the email message of Fig. 5) may be an individual recipient or plurality of individual recipients, but may also be a 'Group recipient', such as an 'email Group' comprising the disclosed 'groups of individuals' or 'group of clients'.

The concept and express disclosure of a 'group' type recipient (aside from an individual recipient of number of recipients) in view of or combined with the disclosed 'embodiments' of Nielsen invention teaches the argued feature of Applicant's claimed invention. The Office asserts that it would be obvious to one of ordinary skill in the art to apply and/or combine the 'recipient' types disclosed by Leonard's invention with Nielsen's express teaching of a method and system that tracks, monitors, and/or deletes email messages previously-sent to a 'recipient' or user. Specifically, in the case wherein Nielsen tracks and monitors to see if a 'recipient' has already read / 'seen' an email message, it would be obvious to one of ordinary skill to monitor the email status of a previously-sent message according to the 'type' of recipient associated with the message: an 'individual recipient', a number of individual recipients, or a 'group recipient' (e.g. 'group' of individuals or clients). The Office notes that the concept of a 'group' type mailbox or addressee is not only expressly disclosed (by Leonard), but also well-known in the art. Since 'tracking and accordingly deleting a previously-sent email message' addressed to the first two recipient 'types' (i.e., individual or individuals) are expressly disclosed by Nielsen, it would thus be an obvious modification to Nielsen's

invention to also carry out the same methodology and steps for a 'recipient', wherein 'recipient' is defined as a 'group' recipient or addressee.

As such, the combination of Nielsen's 'message tracking / deleting' methodology and Leonard's disclosure of a 'group' addressee or recipient type teaches and/or yields essentially the same invention as Applicant's claimed invention. It is obvious to one of ordinary skill that Nielsen's step methodology detailed in Figures 10a-b and 11a-b can be easily adapted and logically implemented for the specific case of a 'group' type addressee or recipient, which means that when the system checks to see if a previously-sent message has already been 'read' by a 'recipient' (step 1011) [Fig.5], it must check for the message status and return a 'Yes' or 'No' in the context of a 'group' recipient (i.e., "Has the effected Message been Seen?" {by at least one member of the 'group'}, as opposed to "Has the effected Message been Seen?" {by the user or by at least one user of the many users to whom the message was sent}). If so, then a 'Yes' or true flag must be returned and the email is not deleted or destroyed; otherwise, it can only mean that none of the users comprising the 'group' addressee has read the message, so a 'No' or false flag is returned, and the message is accordingly deleted for the 'group' recipient / addressee.

This Office remarks that combining or incorporating Leonard with Nielsen is at most a 'logical modification' to Nielsen's invention with little, if any, technical overhaul of the invention, and is thus considered an obvious modification by one of ordinary skill.

Based on the above, the Office asserts that the argued and recited limitation of claim 1 is therefore disclosed by the combination of Nielsen and Leonard, and the rejection of the claim is therefore maintained by the Office. The rejection of the pending claims are thus maintained because the combination of the prior art reference(s) teach or disclose every feature of the claims as required.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

(12) Conclusion

For the above reasons, having shown that Nielsen and/or Leonard expressly teaches and discloses all the recited features of independent Claim 1, as well as the features of the corresponding dependent claims which they are depending, the Office firmly asserts that the rejection of the claimed invention in view of the prior art reference(s) should be sustained.

Respectfully submitted,

Application/Control Number: 10/822,432
Art Unit: 2451

Page 21

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October 24, 2008

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